

### **III. Remarks**

#### **A. Status of the Application**

Claims 32-54 will be pending after entry of the present paper. Claims 24-46 were previously pending. Claims 24-31 are canceled by the present paper without prejudice to or disclaimer of the subject matter therein. New claims 47-54 are added by the present paper. Reconsideration of this application in light of the following remarks is respectfully requested.

#### **B. Allowable Subject Matter**

Applicants appreciate the Examiner's indication that claims 45 and 46 are allowed. New claims 47-54 depend from and further limit claim 45 and, therefore, should be allowable for at least the same reasons.

#### **C. Claim Rejections Under 35 U.S.C. §103**

Claims 24-44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,062,575 to Mickel et al. ("Mickel") in view of U.S. Patent No. 4,060,219 to Crawford ("Crawford"). As noted above, claims 24-31 are canceled by the present paper. Therefore, this rejection will not be addressed with respect to claims 24-31 at this time. Applicants traverse the rejection of claims 32-44 on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

In *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007), the Court stated that "a patent composed of several elements **is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.** Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a **reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.** This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed

discoveries almost of necessity will be combinations of what, in some sense, is already known.”  
*Id.* at 1741 (emphasis added).

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...

In the present application, a *prima facie* case of obviousness has not been factually supported for at least the reasons set forth below.

Even when combined, Mickel and Crawford cannot be applied to reject the pending claims under 35 U.S.C. § 103(a) which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be considered. However, even when combined Mickel and Crawford do not disclose or suggest, all the claim limitations of the pending claims.

With respect to independent claim 32, even when combined, Mickel and Crawford do not disclose or suggest “a first aperture extending from the external surface to the internal surface along a first axis substantially perpendicular to the longitudinal axis, the first aperture having a first length extending substantially along the longitudinal axis between a proximal wall and a distal wall, the first aperture having a first width extending substantially transverse to both the longitudinal axis and the first axis between a pair of sidewalls, wherein the first length is greater than the first width such that the first aperture is elongated along the longitudinal axis and wherein the proximal wall, distal wall, and pair of sidewalls extend in a direction substantially parallel to the first axis.” In that regard, the Office Action notes that Mickel fails to disclose a first aperture as recited and proposes to combine passageway 146 of Crawford with the device of Mickel. Office Action, p.4. However, claim 32 requires the first aperture to extend from the external surface to the internal surface along the first axis substantially perpendicular to the

longitudinal axis. Furthermore, claim 32 requires the first aperture's proximal wall, distal wall, and pair of sidewalls to extend in a direction substantially parallel to the first axis, that is, substantially perpendicular to the longitudinal axis. In contrast, as shown below in FIG. 1, Crawford teaches that passageway 146 "is drilled at a 37° angle with respect to the cylindrical axis of main body 120." Crawford, col.4 ll.32-33.

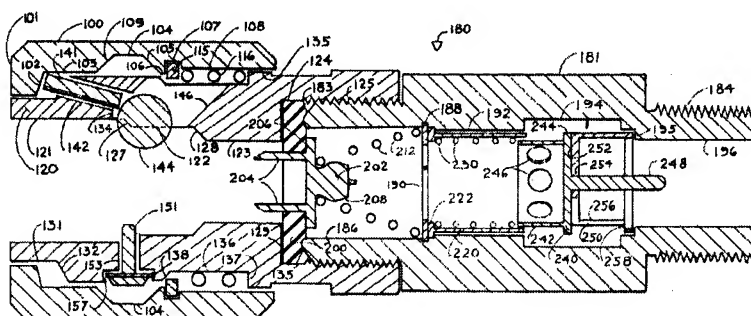


FIG. 1

Passageway 146 and its corresponding walls extending at a 37° angle with respect to the cylindrical axis of main body 120 cannot be considered "a first aperture extending from the external surface to the internal surface along a first axis substantially perpendicular to the longitudinal axis" and "wherein the [first aperture's] proximal wall, distal wall, and pair of sidewalls extend in a direction substantially parallel to the first axis," as recited by claim 32.

The Final Office Action notes that "the examiner reasserts that the hole of Crawford can be considered to be substantially perpendicular. Substantially is a broad term. ... The aperture of Crawford at least extends in a direction perpendicular to the longitudinal direction as the aperture of Crawford extends in many directions, including a perpendicular direction." Final Office Action, p.5 (emphasis original). First, it is entirely unclear how the Examiner is interpreting the passageway of Crawford to extend in "many directions" when Crawford explicitly states that the passageway 146 extends at a 37° angle with respect to the cylindrical axis of the main body 120. Second, the Examiner entirely fails to address what portions of the walls defining passageway 146 are to be considered the recited proximal wall, distal wall, and pair of sidewalls that each extend in a direction substantially parallel to the first axis, which is substantially perpendicular to the longitudinal axis. In that regard, no wall portions of the

passageway 146 extend substantially perpendicular to cylindrical axis of the main body. Rather, all of the wall portions appear to extend at the 37° angle described by Crawford. Finally, as noted in Applicants' previous response, while the term "substantially perpendicular" encompasses more than exactly a 90° angle, one skilled in the art clearly would not consider the 37° angle taught by Crawford to be substantially perpendicular. In that regard, the MPEP clearly notes in §2111.01 that "during examination the USPTO must give claims their broadest reasonable interpretation" and that the "'plain meaning' refers to the ordinary and customary meaning given to the term by those of ordinary skill in the art." Simply put, one skilled in the art would not consider the 37° angle taught by Crawford to be "substantially perpendicular" as recited. Furthermore, one skilled in the art would recognize that a "37° angle", as taught by Crawford, is closer to teaching a parallel (*i.e.*, a 0° angle) with respect to the cylindrical axis of main body 120 than an angle that is substantially perpendicular to the cylindrical axis of main body 120. Accordingly, interpreting the "37° angle" taught by Crawford to be substantially perpendicular is not a reasonable interpretation and can not be considered the ordinary and customary meaning of the term as understood by those of ordinary skill in the art.

Furthermore, the Applicants submit that the Mickel and Crawford patents are not properly combinable as suggested by the Office Action. In that regard, Mickel is directed to "apparatus and methods for coupling a driving shaft [] and a mating tool shaft [] to transmit rotational forces and axial tension and compression between the shafts." Mickel, Abstract. In contrast, the Crawford patent is directed to an "inventive quick disconnect coupler device for connection between a source of compressed air and the flexible air line hose leading to an air operated tool." Crawford, col.2 ll.20-23. That is, Mickel is directed to coupling a tool to a drive shaft, while Crawford is directed to connecting an air supply to an air operated tool. One skilled in the art would not utilize the coupling assembly of an air supply connection—where the connection is substantially fixed and not subjected to high speed rotation—in lieu of a connection for transmitting "rotational forces and axial tension and compression." In that regard, *KSR* notes that when combining elements from different references, it is important to determine whether the element is performing "the same function it had been known to perform." *KSR* at 1740. There is

simply no indication that the quick disconnect air coupler of Crawford is suitable for transmitting high-speed rotational forces. Accordingly, combining the quick disconnect air coupler of Crawford as suggested would likely destroy intended functions of the Mickel device, such as transmitting rotational forces and axial tension and compression between a driving shaft and a mating tool shaft.

Accordingly for at least the reasons stated above Mickel and Crawford are not properly combinable in the manner suggested by the Final Office Action and, even when combined, Mickel and Crawford fail to teach or suggest all of the limitations recited in claim 32. Therefore, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met with respect to independent claim 32. Claims 33-44 depend from and further limit claim 32 and recite additional limitations not disclosed or suggested by the cited references. Thus, Applicants request that the §103 rejection of claims 32-44 over Mickel and Crawford be withdrawn.

#### **IV. Conclusion**

It is believed that all matters set forth in the Office Action have been addressed and that all of the pending claims are in condition for allowance. Accordingly, an indication of allowability is respectfully requested.

The Office Action contains characterizations of the claims and the related art to which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in this or any other Office Action.

Should the Examiner deem that an interview with Applicants' undersigned attorney would further prosecution, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

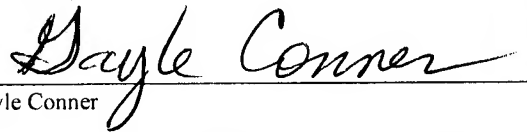


Gregory P. Webb  
Registration No. 59,859

Dated: June 15, 2009  
HAYNES AND BOONE, LLP  
Customer No. 46334  
Telephone: 972-739-8641  
IP Facsimile: 214-200-0853  
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Gayle Conner